

**I. REPLY TO REJECTION OF CLAIMS 1-20 ON THE GROUND OF NONSTATUTORY DOUBLE PATENTING**

Claims 1-20 have been rejected under the judicially created doctrine of obviousness-type double as unpatentable over claims 1-20 of U.S. Patent No. 6,528,076.

In reply Applicant submits a terminal disclaimer under 37 CFR § 1.321(c) on the Form PTO/SB/26 attached hereto. Accordingly, the rejection of originally submitted claims 1-20 under the doctrine of obviousness-type double patenting has been overcome and should be withdrawn.

**II. REPLY TO REJECTION OF CLAIMS 1-3, 13-15, 19 and 20 UNDER 35 U.S.C. § 103(a)**

Claims 1-3, 13-15, 19 and 20 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,216,224 (“‘224”) to Yu et al. (“Yu”). The Office Action asserts that the ‘224 patent to Yu discloses a method of dissolving 0.5 gm of methyl retinoyl salicylate with 5 ml acetone and mixing the solution with 95 gm of hydrophilic ointment. The Office Action concedes that the Yu ‘224 patent does not disclose the concentration of salicylate or acetone, but asserts that absent a clear showing of criticality, the determination of particular concentrations would have been obvious at the time the invention was made to a person having ordinary skill in the art.

In response Applicant emphasizes that the Office Action has failed to establish

*prima facie* obviousness in regard to the rejected claims, for several reasons.

First, in regard to claim construction, all of the rejected claims are directed to a composition that has the capability of treating pain, so that this limitation breathes life and meaning into the claims and therefore must be given weight. The cited example in the Yu patent, however, is not directed to any pain relief capability. Additionally, the Yu patent has no disclosure re pain treatment capability for any of its disclosed compositions. Rather, the entirety of Yu is directed to “compositions and methods for treating the symptoms of psoriasis”. Thus, on this basis alone the rejection fails to establish *prima facie* obviousness, and should be withdrawn.

Second, assuming, *arguendo*, that the pain treatment limitation in the presently rejected claims is given no weight, the rejection fails to establish *prima facie* obviousness because it fails to cite any secondary reference that teaches the elements and limitations of the rejected claims that are not found in Yu. Specifically, the Office Action admits that the “prior art does not disclose the claimed concentration of the salicylate-based compound and the acetone,” but fails to cite any secondary reference that does do so. Thus, on this basis alone the rejection fails to establish *prima facie* obviousness and should be withdrawn.

Third, assuming, *arguendo*, that the pain treatment limitation of the rejected claims is given no weight, and that some unknown, un-cited prior art reference disclosed the salicylate-based compound and acetone concentrations that are not claimed or disclosed in

Yu, then the rejection fails to establish *prima facie* obviousness because there is no showing of motivation to combine the assumed concentrations of the assumed, unknown and un-cited secondary reference with the different concentrations of Yu to provide a composition having pain treatment capability as compared to Yu's compositions that have psoriasis symptom treatment capability. Without such a showing of motivation to combine in the record, there can be no establishment of *prima facie* obviousness. *See, In re Royka*, 490 F.2d 981, 985, (CCPA 1974) (there must be some evidence in the reference or prior art suggesting or showing why a particular modification would be made to a prior art device or process so that the combined teachings of the cited prior art teach *all* of the claim limitations); and *In re Gordon*, 733 F.2d 900, 902, (Fed.Cir. 1984) (the references also must be properly combinable or modifiable, and not teach away from the invention).

### **III. AUTHORIZATION TO CHARGE FEES TO DEPOSIT ACCOUNT**

It is believed that because no amendment to the claims has been made, the only fee to be charged in regard to this reply is for response to the Office Action within the third month extension period as provided by 37 CFR §§ 1.136(a) and 1.17(a) (3), and the Director is specifically requested to charge such fee to Coudert Brothers LLP Deposit Account 50-1434. Also, the Director is hereby authorized and requested, during the prosecution of this application, to charge fees that may be required or credit any

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overpayment of fees to Deposit Account No. 50-1434, except for payment of patent issue fees required under 37 CFR § 1.18. Please show our above-referenced number with any credit or charge to our Deposit Account.

**IV. CONCLUSION**

For all of the above reasons, it is believed that pending claims 1-20 of the above-identified patent application are now in condition for allowance.

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Respectfully submitted,

  
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